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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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FINNEGAN, HENDERSON, FARABOW, GARRETT &  
DUNNER LLP  
1300 I STREET, NW  
WASHINGTON, DC 20005

EXAMINER

CHANNAVAJJALA, LAKSHMI SARADA

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 03/04/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/598,637

Applicant(s)

DE LA POTERIE ET AL.

Examiner

Lakshmi S. Channavajjala

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

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## DETAILED ACTION

Receipt of request for extension of time and request for reconsideration, both dated 12-31-01 is acknowledged.

### *Response to Arguments*

Applicant's arguments with respect to claims 1-31 have been considered but are moot in view of the new ground(s) of rejection.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-47 of U.S. Patent No. 5,945,095. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims also recite a cosmetic composition; which is similar in scope of the instant claims. Both the patented claims and instant claims recite a cosmetic composition comprising at least one fatty substance and a non-aqueous dispersion of surface-stabilized polymer particles in

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at least one liquid fatty substance, wherein the polymer particles being surface stabilized by surface-stabilizing polymer. While the instant claims recite, "for coating keratin fibers", patented claims are also identical in scope because the latter mention the use of eye make up and lengthening the eyelashes. Patented claims do not specifically mention the limitations such as specific weight percentages, viscosity of the polymer of the instant claims. However, the patent uses the same polymers for dispersion, stabilization and mentions the viscosity of 3-30 Pa.S (see patented claim 42). Accordingly, the instant claims would have been obvious over the patented claims.

2. Claims 1-31 directed to an invention not patentably distinct from claims 1-47 of commonly assigned 5,945,095. Specifically, Both the patented claims and instant claims recite a cosmetic composition comprising at least one fatty substance and a non-aqueous dispersion of surface-stabilized polymer particles in at least one liquid fatty substance, wherein the polymer particles being surface stabilized by surface-stabilizing polymer. While the instant claims recite, "for coating keratin fibers", patented claims are also identical in scope because the latter mention the use of eye make up and lengthening the eyelashes. Patented claims do not specifically mention the limitations such as specific weight percentages, viscosity of the polymer of the instant claims. However, the patent uses the same polymers for dispersion, stabilization and mentions the viscosity of 3-30 Pa.S (see patented claim 42).

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302).

Commonly assigned 5,945,095, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under

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35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 CFR 1.78(c) and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

3. Claims 1-31 are rejected under 35 U.S.C. 103(a) as being obvious over US 5,945,095.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in

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accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

5,945,095 teach a cosmetic composition comprising at least one fatty substance and a non-aqueous dispersion of surface-stabilized polymer particles in at least one liquid fatty substance, wherein the polymer particles being surface stabilized by surface-stabilizing polymer. While the instant claims recite, "for coating keratin fibers", which is an intended use, 5,945,095 teach the cosmetic composition for eye make up and lengthening the eyelashes (col. 2, lines 30-39 7 col. 12, lines 12-24). 5,945,095 also teach the same film-forming polymers (col. 4, lines 14-52), liquid fatty phase (col. 4, lines 53 through col. 5, lines 25) and stabilizers col. 7, lines 1-65) and other cosmetic additives and excipients such as those claimed in the instant invention. 5,945,095 do not specifically mention the limitations such as specific weight percentages, viscosity of the polymer of the instant claims. However, the 5,945,095 uses the same polymers for dispersion, stabilization and suggests maintaining a viscosity of 3-30 Pa.S of the composition if the composition is in the form of flexible paste or a cast (col. 10, lines 25-39). Accordingly, it would have been obvious for a skilled artisan at the time of the instant invention to maintain the cosmetic composition of 5,945,095 at an appropriate viscosity of 3-30 Pa.s., depending on the type of product being prepared for example, a pasty product, because 5,945,095 suggests that for mascara or eye make up compositions in the form of flexible paste products, the optimum

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viscosity of 3-30 Pa.s. The expected result is to obtain a paste product for eye care having good coating of the eyelashes.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-31 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 749747 A1.

Examiner notes that English equivalent of the EP 749747 is US 5851517, since both EP and US patents claim priority over the same French Application. Therefore the teachings of US reference are relied upon.

EP teaches a composition containing a dispersion of surface stabilized polymer particles in a non-aqueous medium. EP suggests using polymers such as those used for nail polish or mascara (col. 1, lines 10-20 and col. 8 of US patent). EP teaches the same polymers i.e., acrylic or vinyl radical copolymers etc., such as those claimed in the instant (col. 2) and the non-aqueous liquid components such as natural, synthetic, carbon-based or hydrocarbon based oils (col. 3). EP further teaches the stabilizers such as sequential or grafted block copolymers, with 2-30% by weight of the stabilizer (col. 5 through 6). EP fails to teach the viscosity of the composition, as claimed in the instant. However, EP teaches various formulations such as gels (example 13), milky dispersion (example 8), and oils etc., which are different in their viscosities. Accordingly, it would have been obvious for a skilled artisan at the time of the instant invention to prepare various cosmetic formulations containing surface stabilized polymers in fatty phase, which

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exhibit different viscosities depending on the type of the formulation. Further, because EP teaches the same polymers, solvents, stabilizers and other cosmetic ingredients in their composition, it is the position of the examiner that absent showing evidence on the contrary, the cosmetic compositions of EP exhibit the same viscosity as that claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 703-308-2438. The examiner can normally be reached on 7.30 AM -4.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7924 for regular communications and 703-308-7924 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Lakshmi S. Channavajjala  
Examiner  
Art Unit 1615

February 28, 2002

THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600